

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte KUAN LIN WANG

Appeal No. 2004-0364
Application No. 09/943,293

ON BRIEF

Before ABRAMS, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 4,
which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a nozzle which is slidably connected to the base of a nailer so that the nozzle can be conveniently replaced according to needs (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Perkins	3,853,257	Dec. 10, 1974
Chen	5,642,849	July 1, 1997

Claims 1 and 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Chen in view of Perkins.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 4, mailed January 10, 2003) and the answer (Paper No. 7, mailed August 1, 2003) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 6, filed June 10, 2003) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 and 4 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellant argues that it would not have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Chen based on the teachings of Perkins to arrive at the claimed subject matter. We agree.

Claim 1 recites a nozzle assembly for nailers comprising, inter alia, a base plate connected to an end of a magazine adapted to be connected to a body of the nailer; a plurality of openings defined through the base plate and communicating with a plurality of slots defined in a side of the magazine; a nozzle having two wings and each wing having a groove in which one of two sides of the base plate is slidably received; pins extending through the wings and engaged with the base plate; a plurality of nail guide holes defined through the nozzle and communicating with the openings; two hooks extending from the nozzle; and a cap mounted on the nozzle and having two apertures through which the hooks are engaged.

Claim 4 recites a nozzle assembly for nailers comprising, inter alia, a base plate connected to an end of a magazine adapted to be connected to a body of the nailer; the base plate having two grooves defined therein; a plurality of openings defined through the base plate and communicating with a plurality of slots defined in a side of the magazine; a nozzle slidably engaged with the two grooves of the base plate; a plurality of nail guide holes defined through the nozzle and communicating with the openings; two hooks extending from the nozzle; and a cap mounted on the nozzle and having two apertures through which the hooks are engaged.

Chen's invention relates to a nail driving gun, more particularly to a barrel unit with a removable cover plate for a nail driving gun. Referring to Figure 5, the preferred embodiment of a barrel unit according to Chen's invention is shown to be installed on a front end of a nail driving gun 30 and includes an elongated base plate 40 and an elongated cover plate 50 to be superimposed on the base plate 40. The base plate 40 extends forwardly from the housing of the nail driving gun 10 and has a top side formed with a longitudinal discharge groove 400, a pair of upwardly extending positioning lugs 41 which are disposed respectively on opposite sides of the discharge groove 400 and which are located at a rear portion of the base plate 40, and a pair of upwardly extending hooking lugs 42 which are disposed respectively on opposite sides of the discharge groove 400 and which are located at a front portion of the base plate 40. Each of the positioning lugs 41 has a rearwardly inclining rear end surface 411.

Chen's cover plate 50 is formed with a pair of first slots 51 and a pair of second slots 52 which permit extension of a respective one of the positioning lugs 41 and the hooking lugs 42 therethrough. Preferably, the first and second slots 51, 52 are slightly longer than the respective one of the positioning lugs 41 and the hooking lugs 42. Each of the first slots 51 has a rearwardly inclining end wall surface 511 which abuts against the rear end surface 411 of the respective one of the positioning lugs 41 when the cover plate 50 is superimposed on the base plate 40. An operating lever 53 is mounted

pivotally on the cover plate 50 and is located between the first and second slots 51, 52.

A U-shaped fastener 54 has two ends connected pivotally to the operating lever 53.

Perkins' invention is directed to a self-clearing nose section for a powered fastener-driving tool. As shown in Figures 1-6, a nose section 13 for a powered fastener-driving tool T is provided which includes a fixedly mounted inner plate 17, and a removable outer plate 21 which is mounted in face-to-face relation on the inner plate. The plates cooperate with one another to form an elongated guideway 22 into which the fasteners are successively fed and from which they are subsequently discharged by a reciprocating driver element 14. Overlying the outer plate and mounted for slidable movement thereon is a guard piece 24 which is adapted to cooperate with a safety device to render the trigger for the tool either operative or inoperative depending upon the relative position of adjustment of the guard piece with respect to the outer plate. A pair of adjustable arms 30 and 31 are provided which overlie the guard piece and, when in one position of adjustment, resiliently maintain the inner and outer plates in assembled face-to-face relation.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Chen and claim 1, it is our opinion that one difference is the limitation that the nozzle has two wings and each wing has a groove in which one of two sides of the base plate is slidably received. Based on our analysis and review of Chen and claim 4, it is our opinion that one difference is the limitation that the nozzle is slidably engaged with the two grooves of the base plate.

As set forth above, a prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. In this case, it is our opinion that there is no evidence in the combined teachings of Chen and Perkins that would have led one of ordinary skill in the art to have modified Chen to arrive at the claimed invention. Thus, it is our view that the only suggestion for modifying Chen in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 1 and 4 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 4 under 35 U.S.C. § 103 is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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Appeal No. 2004-0364
Application No. 09/943,293

Page 9

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